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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,747	10/13/2000	Douglas G. Gardner	LAM2P135.CIP	1314

7590

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EXAMINER

MARKOFF, ALEXANDER

ART UNIT

PAPER NUMBER

1746

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/687,747

Applicant(s)

GARDNER ET AL.

Examiner

Alexander Markoff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-16,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,11-13,15,16,18 and 19 is/are rejected.
- 7) ☒ Claim(s) 9,10 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-6, 15, 16, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Chai et al (US Patent NO 5,839,460).

Chai et al a method and apparatus as claimed. See entire reference, especially Fig. 14, 13 and columns 8-12.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

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later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 3-6, 15, 16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (US Patent No 5,862,560) in view of Chai et al (US Patent NO 5,839,460).

Jensen et al teach the apparatus as claimed except for the grooves for receiving the substrate being formed by O-rings.

However, Chai et al teach that forming grooves by the O-rings held between the plates was conventional in the art. They teach the device with the grooves formed by O-rings as an alternative to the device wherein the grooves are formed from a piece of an elastomeric material.

It would have been obvious to an ordinary artisan at the time the invention was made to form grooves of the rollers in the apparatus of Jensen et al from O-rings with reasonable expectation of adequate results because Chai et al teach

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the grooves formed by O-rings as a preferred alternative to the grooves formed in a piece of material.

7. Claims 7, 8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 1058 296.

EP 1058296 teaches the roller as claimed except for fastening the plates with controlled force.

See entire reference, especially Fig. 5b and the related description and columns 5-6.

The reference is silent regarding the way by which the parts of the roller are fasten to each other.

However, it would have been obvious to an ordinary artisan at the time the invention was made to fasten the parts of the roller with a force needed to prevent the slippage of the rings and moving the part relative to each other in order to enable the roller to perform the disclosed function. Accordingly it would have been obvious tan ordinary artisan t the time the invention was made to provide the roller of EP 1058296 with a fastening means to enable that.

As to claim 8: EP 1058296 fails to teach the holes in the clamp plate for screws.

However, the use of screws to fasten different parts together is notoriously well-known in the art.

It would have been obvious to an ordinary artisan at the time the invention was made to fasten the parts of the roller of EP 1058296 together by any

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conventional means, including the screws with reasonable expectation of adequate results. In this case it would have been obvious to an ordinary artisan that the plates should be provided with holes to enable the placement of the screws.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 3-16, 18, and 19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

9. Claims 9, 10 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach the roller as claimed.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No 5,840,129 is cited to show the details of the conventional roller, specifically the roller referenced in Jensen et al. US Patent 6,439,245 is cited to show what was disclosed in the parent application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number

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is 703-308-7545. The examiner can normally be reached on Monday - Friday  
8:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, Randy P. Gulakowski can be reached on 703-308-4333.

Any inquiry of a general nature or relating to the status of this application  
or proceeding should be directed to the receptionist whose telephone number is  
703-308-0651.



Alexander Markoff  
Primary Examiner  
Art Unit 1746

am

8/20/03

**ALEXANDER MARKOFF**  
**PRIMARY EXAMINER**